

## **REMARKS**

Claims 1, 12-15, 19 and 20 have been amended. No claims have been added or canceled. Claims 1-20 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Request for Telephone Interview:**

Applicant has made a good faith effort to resolve all issues preventing allowance of this application. Applicant also notes the lengthy pendency of this application. If any issues remain preventing allowance of the application, Applicant requests a telephone interview before any further action is sent. Applicant's representative may be contacted at 512-853-8850.

### **Objection to the Drawings:**

The Office Action objected to Figure 10 of the drawings for allegedly failing to comply with 37 CFR 1.84(p)(5). More specifically, the Office Action asserts that element 322 of Figure 10 is not mentioned in the detailed description. Applicant asserts that this objection is improper because the specification references element 322 in multiple instances. For example, line 12 of page 18 mentions "package processors 322-324" and line 25 of page 36 mentions "package processing apparatuses 322-324." Accordingly, Applicant respectfully requests removal of this objection with respect to element 322.

The Office Action also objected to the drawings for allegedly failing to comply with 37 CFR 1.84(p)(5) because the drawings fail to include reference sign 186, which is described in paragraph 89 of Applicant's specification. Applicant notes that reference sign 186 has been added to the appropriate block in Figure 8 of the replacement sheet submitted herewith. The addition of reference sign 186 to Figure 8 is also noted on the

annotated sheet submitted herewith. Accordingly, Applicant respectfully requests removal of this objection with respect to reference sign 186.

In regard to each of the remaining objections to the drawings specified on page 2 of the Office Action mailed April 14, 2009, Applicant asserts that such objections are overcome by the amendments to the specification, which are presented above. Accordingly, Applicant respectfully requests removal of the remaining objections to the drawings.

**Section 112, Second Paragraph, Rejection:**

The Office Action rejected claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite. More specifically, the Office Action asserts the phrase “cost effective” is vague and indefinite. Applicant traverses the rejection. However, to expedite prosecution, claim 1 has been amended to recite, in part, “searching a database to select particular insurance for the item according to one or more insurance criteria.” Moreover, claim 1 as amended does not include the phrase “cost effective.” Accordingly, Applicant respectfully requests removal of the § 112 rejection of claim 1 and claims dependent thereon.

**Section 101 Rejection:**

The Office Action rejected claims 1-18 under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter. Applicant traverses the rejection. However, to expedite prosecution, the limitation “...performing via one or more computers...” has been added to claim 1. Accordingly, Applicant respectfully requests removal of the § 101 rejection of claim 1 and claims dependent thereon.

### **Section 103(a) Rejections:**

The Office Action rejected claims 1, 2, 4-9 and 12-15 under 35 U.S.C. § 103(a) as being unpatentable over Harrell et al. (U.S. Publication 2002/0156656) (hereinafter “Harrell”) in view of Vaghi (U.S. Patent 6,047,273), claim 3 as being unpatentable over Harrell in view of Vaghi and further in view of Welles et al. (U.S. Patent 5,686,888) (hereinafter “Welles”), claims 10, 11, 16 and 17 as being unpatentable over Harrell in view of Vaghi and further in view of Bennett et al. (U.S. Patent 7,117,170 (hereinafter “Bennett”), and claim 18 as being unpatentable over Harrell and Vaghi and further in view of Kepler (U.S. Patent 5,347,845). Applicant respectfully traverses these rejections for at least the following reasons.

### **Eligibility of Harrell as a Prior Art Reference**

**Applicants note that the rejection is improper because the subject matter of Harrell relied upon in the rejection has not been shown to be prior art to the present application.** More specifically, Harrell is a published U.S. patent application that was filed on Aug. 28, 2001, **after** the priority date established by Applicant’s provisional application (U.S. Provisional Application No. 60/246,640, filed Nov. 10, 2000). Harrell does claim the benefit of a provisional application filed Aug. 29, 2000. However, the Aug. 29, 2000 filing date can only be used as Harrell’s 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application, it is unclear whether the material in Harrell relied upon by the Examiner was actually present in Harrell’s provisional application. The Examiner must show that the subject matter on which the Examiner is relying on to reject Applicants’ claims is also present in Harrell’s provisional application. Until the Examiner has made this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Moreover, Harrell's published application is not entitled to the Aug. 29, 2000 date as a section 103(a) prior art date unless at least one claim of Harrell's published application is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. The rejection is improper unless the Examiner can show that Harrell's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 103(a) prior art date. *See also* M.P.E.P. § 2136.03(IV).

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that both of the above requirements have been met for Harrell's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.

### **Claim 1**

**In regard to claim 1, the cited art fails to teach or suggest i) generating a data file comprising at least the following: item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, and ii) storing the data file in a memory device that accompanies the item during said shipment.** The Office Action relies on the teachings of Harrell and Vaghi to teach the limitations Applicant's claim. More specifically, in regard to "storing the data file in a memory device that accompanies the item during said shipment," the Office Action cites the "stored data" of Figure 1 of Harrell. The Office Action also indicates that the "stored data" of Harrell is considered equivalent to the claimed "data file." **First**, the "stored data" of Figure 1 of Harrell is merely a symbol of the legend. For the actual stored data represented by such symbol, one must refer to Figure 2 of Harrell, which illustrates stored data "2-S1" and "2-S2." While stored data

“2-S2” is illustrated as “system preload of transactional information” and stored data “2-S1” is illustrated as “system preload of insured party information,” the cited art fails to teach that such data includes both item information and insurer information, as claimed. Accordingly, the “stored data” taught by Harrell cannot be considered to be the same as Applicant’s claimed “data file.” **Second**, even if such “stored data” could somehow be considered as being the same as the claimed “data file,” **the cited art fails to teach or suggest storing the “stored data” of Harrell “in a memory device that accompanies the item during said shipment.”** In fact, Harrell fails to teach or suggest storing anything within a memory device that accompanies an item during shipment, much less storing the particular type of data file claimed in such a memory device. Vaghi fails to overcome such deficiencies. For instance, neither Harrell nor Vaghi (considered singly or in combination) teach a memory device that accompanies an item during shipment, much less storing the particular type of data file of claim 1 within such a memory device.

**Furthermore, the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment.** The Office Action acknowledges that Harrell fails to teach the aforesaid limitation (*see e.g.*, page 4 of Office Action mailed April 14, 2009). The Office Action relies on the teachings of Vaghi to teach the aforesaid limitation. More specifically, the Office Action cites column 5, line 21 – column 6, line 32 of Vaghi. The Office Action asserts that such portion of Vaghi teaches “a database of options, including insurance options.” While Vaghi very briefly mentions “insurance options” as a feature of his computer program (*see e.g.*, column 6, line 20), nowhere does Vaghi teach “searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment.” **In fact, the brief disclosure of “insurance options” does not teach anything about a database or a particular manner in which to search a database, such as the manner of claim 1. Furthermore, the simple disclosure of “insurance options” does not inherently include searching a database according to the specific limitations of claim 1.** More specifically, one of

ordinary skill in the art would immediately recognize that, in Vaghi's computer program, "insurance options" could be provided as a simple user-interface component. For example, one way in which one of ordinary skill in the art might provide "insurance options" would be to provide a query, such as "Check yes or no to indicate that you would like insurance." This is only one example of a non-database implementation of providing "insurance options." One skilled in the art would be familiar with other ways to provide Vaghi's "insurance options" without utilizing a database, much less searching a database according to the specific limitations of claim 1.

Even were the teachings of the cited art somehow combined as suggested by the Office Action, such a combination would not result in Applicant's claimed invention for at least the reasons presented above.

**Furthermore, Applicants assert the Office Action has not provided a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Vaghi with the teachings of Harrell.** The Office Action asserts that such a combination would be performed "with the motivation of providing a tool to enable customers to remotely use a mailing/shipping service via the use of a rate table (column 2, line 65 through column 3, line 17)." However, there would be no reason to combine the teachings of Vaghi with the teachings of Harrell in the manner suggested by the Office Action because Harrell already "provid[es] a tool to enable customers to remotely use a mailing/shipping service" (see Abstract of Harrell, "on-line automation of quoting, billing, [etc.]" ). As for providing such service "via the use of a rate table" as suggested by the Office Action, Harrell already includes a "rate formula" (paragraph [0124]) and thus there would be no need to utilize "rate tables" as described by Vaghi. Furthermore, utilizing "rate tables" as taught by Vaghi would add unnecessary overhead and complexity to Harrell's system since Harrell provides his service through a web site and Vaghi delivers his "rate tables" that are updated via email (see e.g., Abstract of Vaghi). In light of the above, combining the teachings of Vaghi with the teachings of Harrell as suggested by the Office Action would add no additional functionality to Harrell's system and at the same time increase the complexity of Harrell's system.

Clearly, one of ordinary skill in the art would not combine the teachings of the cited art for the reasons set forth in the Office Action.

For at least the reasons presented above, the rejection of claim 1 is unsupported by the cited art and removal thereof is respectfully requested. Similar remarks apply to claims 19 and 20.

#### **Claims 19 and 20**

The rejection of claims 19 and 20 is not supported by the cited art for at least reasons presented above with respect to claim 1.

**Furthermore, the Office Action failed to state a *prima facie* rejection of claims 19 and 20 because the Office Action failed to address specific limitations of 19 and 20.** For instance, claim 19 recites “search a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides maximum insurance coverage for the item during said shipment for the least cost” (claim 20 includes a similar limitation). **The Office Action rejected claims 19 and 20 for under the rationale used to reject claims 1, 2 and 6 (see page 7 of Office Action mailed April 14, 2009). However, claims 1, 2, and 6 are not commensurate with the aforesaid claim limitation of claim 19.** None of claims 1, 2 and 6 recite “search a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides maximum insurance coverage for the item during said shipment for the least cost.” **Accordingly, the Office Action failed to state a *prima facie* rejection of claims 19 and 20.** Nor does the cited art teach or suggest the aforesaid limitation of Applicant’s claim.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be

unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicant reserves the right to present additional arguments.



## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

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